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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,554	08/02/2001	Walter Keller	2633-PA78	4639
27111	7590	11/17/2005	EXAMINER	
GORDON & REES LLP 101 WEST BROADWAY SUITE 1600 SAN DIEGO, CA 92101			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/890,554

Applicant(s)

KELLER, WALTER

Examiner

Dan Kesack

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20020312.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been reviewed. Original claims 1-15 are pending. The rejections are as stated below.

#### ***Claim Objections***

2. Claims 5-15 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the word "especially" in line 2 renders the claim indefinite because a narrow range or limitation within a broad range or limitation fails to clearly define the claimed invention and the patent protection desired. The phrase "its own fee database" in line 5 renders the claim indefinite because it is not clear what part of the invention is referred to by the word "its". The phrase "comparable facilities" in line 6 renders the claim indefinite for failing to define the invention, including what comprises a "comparable facility".

Regarding claim 2, the parenthetical phrase in line 3 renders the claim indefinite because the terms enclosed represent examples only, and ends with the word "etc.", which fails to clearly point out the metes and bounds of the claimed invention.

Regarding claims 3 and 4, the phrase "fee databases" in line 2 of claim 3 and "the databases" in line 2 of claim 4, lacks antecedent basis, since only one database is disclosed in preceding claims 1 and 2, from which claims 3 and 4 depend.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Jagadish et al, U.S. Patent No. 6,058,170 in view of Saari et al, U.S. Patent No. 6,338,046.

Claim 1, 3, 4, Jagadish discloses a method and system for automatically generating telephone bills, including a billing analysis system which performs call pricing in real-time," (column 2 line 48) and "using information stored in a customer profile, containing customer specific pricing data that is used to price the calls" (column 4 lines 43-44). Jagadish also discloses transmitting the data to the user online "whenever summary information reaches a predetermined threshold, or whenever desired" (column 4 lines 14-16), bills including "fully custom summary information" which "may be defined directly by the customer or based on summary information requested by the customer" (column 3 lines 61-66). Jagadish also discloses that the system may be directed to many different communication devices (column 5 lines 45-48).

Jagadish fails to teach using access to comparable facilities of service or content suppliers involved, and telecommunications and transmission systems involved.

Saari discloses a system and method for determining charges for usage of a network connection. Saari teaches a user requesting a transfer of information, a transfer of information by an information source, the information source acting as both the content supplier and the transmission system, and a communication of billing information between the information source and the system node connected to the information destination, the system node using the billing information, which represents the cost of using the connection, processing said billing information, and delivering a connection invoice to the user of the connection (column 5 lines 24-50). It would have been obvious to one skilled in the art at the time of the Applicant's invention to access said billing information along with the system disclosed in Jagadish, so as to attain an accurate, and complete report on the total cost of the transmission as incurred by all parties involved.

Claim 2, Jagadish discloses a customer profile associated with the billing analysis system, said customer profile containing customer specific pricing data that is used to price the call (column 4 lines 43-45).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HANI M. KAZIMI  
PRIMARY EXAMINER